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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,785	01/31/2002	Robert H. Folk II	D2737	3363

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EXAMINER	
NGUYEN, JIMMY H	

ART UNIT	PAPER NUMBER
2673	

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/062,785	FOLK, ROBERT H.	
	Examiner	Art Unit	
	Jimmy H. Nguyen	2673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is made in response to applicant's amendment filed on 11/12/2004. Claims 1-23 are currently pending in the application. An action follows below:

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 2 and 4-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al. (USPN: 6,593,973 B1), hereinafter Sullivan, in view of Jambhekar et al. (USPN: 5,848,356), hereinafter Jambhekar, and further in view of Akioka et al. (EP 0 852 371 A1), hereinafter Akioka.

As per claims 1, 11 and 23, Sullivan discloses a device and an associate method for incorporating a graphic with a received video broadcast displayed on a display device, the device comprising a remote server (a network 118, fig. 1) for providing a graphic data (a superimposed video signal, col. 3, lines 1-6) and a display device (a display device comprising elements 122, 124, 126, 128, 202, 20, 227 and 228, see fig. 1) adapted to display a broadcast video received from a CATV (110) or a satellite (112) and the graphic data from the remote server, and comprising a display interface (a display interface comprising elements 122, 124, 126, 202, 20, 227 and 228, see fig. 1) for overlaying the graphic image data on the received video signal or video stream (i.e., the claimed video broadcast). See col. 2, lines 51-65, and fig. 4. Accordingly, Sullivan discloses all the limitations of claims 1, 11 and 23 except for an input device or a

combination of an input module and a communication module, adapted to receive, to store an instruction corresponding to a graphic data and to transmit graphic data to a remote server, and both the graphic data and the received broadcast video simultaneously displayed on the display device, as claimed.

However, Jambhekar expressly teaches an input device (a radio communication 103, fig. 1) comprising an input module (a module including elements 115, 119, 121, 123, 125, 127 and 129, fig. 1) adapted to receive and to store an instruction corresponding to a graphic data (figs. 10s, col. 8, lines 5-44) and a communication module (a radio circuitry 113, fig. 1) for transmitting graphic data to a remote server (a remote transceiver 101) (col. 3, lines 36-45). It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide an input device in the device of Sullivan, in view of the teaching in the Jambhekar, because this would provide a user an easier way to compose and to transmit his message to others, as taught by Jambhekar (col. 8, line 60 through col. 9, line 5). However, the combination of Jambhekar and Sullivan fails to teach both the graphic data and the received broadcast video simultaneously displayed on the display device, as claimed.

However, Akioka expressly teaches a display device (a child device 1, see fig. 1) comprising a display interface (an interface including elements 2, 3, 5, 8-10, 12-14, 16 and 17, see fig. 1) overlaying the graphic data (still image data, text data, figure information and icon and window data, see fig. 3, col. 5, lines 7-26) on the received broadcast video (moving picture data, fig. 3, col. 5, lines 4-7), so that both the graphic data and the broadcast video are simultaneously displayed on the display device (see fig. 3). To the extend that one skilled in the art would recognize Akioka teaching both the graphic data and the broadcast video simultaneously

displayed on the display device in a period during which the broadcast video is displayed on the display device. Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to utilize the teaching of Akioka, i.e., both the graphic data and the received broadcast video simultaneously displayed on the display device in a period during which the broadcast video is displayed on the display device, in the Sullivan apparatus, because this would allow the user simultaneously viewing a plurality of image sources displayed on the display device.

Regarding to claims 2 and 12, as noting in fig. 10, Jambhekar further teaches the instruction including destination address information (see step 1030 and 1032) and the step of transmitting the graphic data to a remote server, in order to transmit the graphic data (an email or a fax or a message) to the selected recipient only.

Regarding to claims 4 and 13, as noting in fig. 10C, Jambhekar further teaches the input device comprising a stylus and a touch screen device.

Regarding to claims 5 and 15, as noting in fig. 1, Jambhekar further teaches the input device being a wireless handheld communicating device.

Regarding to claims 6 and 16, Sullivan further teaches the remote server (118) comprising an Internet server (col. 5, lines 7-8).

Regarding to claims 7 and 14, Jambhekar further teaches that the remote server (101) can be considered as an addressable set-top box for directly transmit the user instruction from the input device (103) to selected recipient (fig. 1).

Regarding to claims 8 and 20, Sullivan's the display interface can be considered as a set-top box adapted to overlay graphics images on a received video broadcast displayed on a display device (fig. 1, col. 2, line 51 through col. 3, line 6).

Regarding to claims 9 and 22, Sullivan's remote server (118) and display interface can considerably comprises a personal video recorder adapted to receive and to overlay the graphical data on the broadcast video (fig. 1 and col. 2, line 32 though col. 3, line 6).

Regarding to claim 10, Sullivan further teaches the display device comprising a television in order to receive a television signal via a CATV (110) (fig. 1).

Regarding to claims 17 and 19, Sullivan further teaches the communication module comprising a modem for receiving the data from the network (col. 2, line 41).

Regarding to claim 18, Sullivan further teaches the remote server comprising a computer (col. 4, lines 27-31).

Regarding to claim 21, Jambhekar further teaches the graphical data comprising text (fig. 10C).

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan in view of Jambhekar and Akioka as applied to claim 2 above, and further in view of Dailey (USPN: 5,642,350).

Regarding to claim 3, as discussed above, Sullivan teaches a display interface, but does not expressly teach a plurality of remote display interfaces arranged in a peer-to-peer network. Accordingly, Sullivan in view of Jambhekar discloses all the limitations of claim 3 except for a plurality of remote display interfaces arranged in a peer-to-peer network.

However, Dailey expressly teaches that a plurality of remote devices arranged in a peer-to-peer network to permit every device on the network to initiate as well as receive messages from other devices on the network is well-known to those of ordinary skill in the art (col. 2, lines 14-17). It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide a plurality of remote display interfaces arranged in a peer-to-peer network in the device of Sullivan because this would permit every device on the network to initiate as well as receive messages from other devices on the network, as taught by Dailey (col. 2, lines 14-17).

5. Claims 1, 2 and 4-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al. (USPN: 6,593,973 B1), hereinafter Sullivan, in view of Jambhekar et al. (USPN: 5,848,356), hereinafter Jambhekar, and further in view of De Haan (US 2003/0117529 A1).

As per claims 1, 11 and 23, Sullivan discloses a device and an associate method for incorporating a graphic with a received video broadcast displayed on a display device, the device comprising a remote server (a network 118, fig. 1) for providing a graphic data (a superimposed video signal, col. 3, lines 1-6) and a display device (a display device comprising elements 122, 124, 126, 128, 202, 20, 227 and 228, see fig. 1) adapted to display a broadcast video received from a CATV (110) or a satellite (112) and the graphic data from the remote server, and comprising a display interface (a display interface comprising elements 122, 124, 126, 202, 20, 227 and 228, see fig. 1) for overlaying the graphic image data on the received video signal or video stream (i.e., the claimed video broadcast). See col. 2, lines 51-65, and fig. 4. Accordingly, Sullivan discloses all the limitations of claims 1, 11 and 23 except for an input device or a combination of an input module and a communication module, adapted to receive, to store an

instruction corresponding to a graphic data and to transmit graphic data to a remote server, and both the graphic data and the received broadcast video simultaneously displayed on the display device, as claimed.

However, Jambhekar expressly teaches an input device (a radio communication 103, fig. 1) comprising an input module (a module including elements 115, 119, 121, 123, 125, 127 and 129, fig. 1) adapted to receive and to store an instruction corresponding to a graphic data (figs. 10s, col. 8, lines 5-44) and a communication module (a radio circuitry 113, fig. 1) for transmitting graphic data to a remote server (a remote transceiver 101) (col. 3, lines 36-45). It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide an input device in the device of Sullivan, in view of the teaching in the Jambhekar, because this would provide a user an easier way to compose and to transmit his message to others, as taught by Jambhekar (col. 8, line 60 through col. 9, line 5). However, the combination of Jambhekar and Sullivan fails to teach both the graphic data and the received broadcast video simultaneously displayed on the display device, as claimed.

However, De Haan expressly teaches a graphic data (an overlay graphic 3 as shown in fig. 1b, or an overlay text 4 as shown in fig. 1c) overlaying on the received broadcast video (a basic information image 2 (see figs. 1b and 1c), so that both the graphic data (3/4) and the broadcast video (2) are simultaneously displayed on the display device (a television 7, see figs. 1b and 1c). To the extend that one skilled in the art would recognize De Haan teaching both the graphic data and the broadcast video simultaneously displayed on the display device in a period during which the broadcast video is displayed on the display device. Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to utilize the

teaching of De Haan, i.e., both the graphic data and the received broadcast video simultaneously displayed on the display device in a period during which the broadcast video is displayed on the display device, in the Sullivan apparatus, because this would allow the user simultaneously viewing a plurality of image sources displayed on the display device, as taught by De Haan (see Abstract).

Regarding to claims 2 and 12, as noting in fig. 10, Jambhekar further teaches the instruction including destination address information (see step 1030 and 1032) and the step of transmitting the graphic data to a remote server, in order to transmit the graphic data (an email or a fax or a message) to the selected recipient only.

Regarding to claims 4 and 13, as noting in fig. 10C, Jambhekar further teaches the input device comprising a stylus and a touch screen device.

Regarding to claims 5 and 15, as noting in fig. 1, Jambhekar further teaches the input device being a wireless handheld communicating device.

Regarding to claims 6 and 16, Sullivan further teaches the remote server (118) comprising an Internet server (col. 5, lines 7-8).

Regarding to claims 7 and 14, Jambhekar further teaches that the remote server (101) can be considered as an addressable set-top box for directly transmit the user instruction from the input device (103) to selected recipient (fig. 1).

Regarding to claims 8 and 20, Sullivan's the display interface can be considered as a set-top box adapted to overlay graphics images on a received video broadcast displayed on a display device (fig. 1, col. 2, line 51 through col. 3, line 6).

Regarding to claims 9 and 22, Sullivan's remote server (118) and display interface can considerably comprises a personal video recorder adapted to receive and to overlay the graphical data on the broadcast video (fig. 1 and col. 2, line 32 though col. 3, line 6).

Regarding to claim 10, Sullivan further teaches the display device comprising a television in order to receive a television signal via a CATV (110) (fig. 1).

Regarding to claims 17 and 19, Sullivan further teaches the communication module comprising a modem for receiving the data from the network (col. 2, line 41).

Regarding to claim 18, Sullivan further teaches the remote server comprising a computer (col. 4, lines 27-31).

Regarding to claim 21, Jambhekar further teaches the graphical data comprising text (fig. 10C).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan in view of Jambhekar and De Haan as applied to claim 2 above, and further in view of Dailey (USPN: 5,642,350).

Regarding to claim 3, as discussed above, Sullivan teaches a display interface, but does not expressly teach a plurality of remote display interfaces arranged in a peer-to-peer network. Accordingly, Sullivan in view of Jambhekar discloses all the limitations of claim 3 except for a plurality of remote display interfaces arranged in a peer-to-peer network.

However, Dailey expressly teaches that a plurality of remote devices arranged in a peer-to-peer network to permit every device on the network to initiate as well as receive messages from other devices on the network is well-known to those of ordinary skill in the art (col. 2, lines 14-17). It would have been obvious to a person of ordinary skill in the art at the time of the

invention was made to provide a plurality of remote display interfaces arranged in a peer-to-peer network in the device of Sullivan because this would permit every device on the network to initiate as well as receive messages from other devices on the network, as taught by Dailey (col. 2, lines 14-17).

Response to Arguments

7. Applicant's arguments filed 11/12/2004 have been fully considered but they are not persuasive.

i. With respect to the rejection to claims 1, 2 and 4-23 under 35 USC 103(a) as being unpatentable over Sullivan in view of Jambhekar and Akioka, applicant argue "Assuming ..., Sullivan et al. cannot be combined with Jambhekar et al. and Akioka et al. to arrive at the claimed invention because it is improper to combine references where the references teach away from their combination ... is not proper", see page 8, 10-27, of the amendment. Examiner disagrees because while Sullivan teaches overlaying a transition video (i.e., the claimed graphic data) during a transition period and does not teach expressly overlaying during a non-transition period; however, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to recognize that by utilizing the teaching of Akioka, i.e., both the graphic data and the received broadcast video simultaneously displayed on the display device in a period during which the broadcast video is displayed on the display device (i.e., a non-transition period), in the Sullivan apparatus, the modified Sullivan apparatus is capable to overlay the graphic data on the received broadcast video not only during a transition period, but also during a non-transition period, so as to allow the user simultaneously viewing a plurality of image sources displayed on the display device, as taught by Akioka.

ii. With respect to the applicant's argument regarding to the rejection to claims 1, 2 and 4-23 under 35 USC 103(a) as being unpatentable over Sullivan in view of Jambhekar and De Haan, a similar response as discussed in paragraph (i) above is applied.

8. Applicant has amended claims 1, 2, 11, 15 and 23 to overcome the objections in the Office Action dated 8/11/2004. The objections to these claims are hereby withdrawn.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sprague et al. (US: 2004/0012717 A1) discloses a related apparatus (a system 10, see fig. 1) capable of transmitting graphic data from an input device (a first workstation 12, fig.1) to another user computer (14), which is capable of overlaying the graphic data from the input device on the received video broadcast signal (22), and displaying the broadcast video and the graphic data simultaneously on the display device (16). See figs. 2, 4 and 5 and the corresponding description.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is (571) 272-7675. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at (571) 272-7681. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JHN
March 31, 2005

Jimmy H. Nguyen
Primary Examiner
Art Unit: 2673